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10/628,749	07/28/2003	Philip G. Wessells	20003-7003	4857

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EXAMINER
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COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/628,749

Applicant(s)

WESSELLS, PHILIP G.

Examiner

Daniel J. Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004 and 02 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-4,6,11,12 and 14-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4,6,11,12 and 14-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20040915.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the feature(s) canceled from the claim(s). No new matter should be entered:

- the image capture system (as recited in claim 28)
- the image storing system (as recited in claim 29)
- the image transmission system (as recited in claim 30)
- the stenciling system (as recited in claim 32)
- the stamping system (as recited in claim 33)
- the transfer medium registration system that locates a bottom-most transfer medium of the pad (as recited in claims 41, 46 and 48)

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the

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drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claim 6 is objected to because of the following informalities: it appears that applicant may have intended claim 6 to recite, , --wherein said cartridge adapts to--. The recitation of, “said cartridge adapts a plurality of pads” does not appear to be accurate since it does not appear that the pads are modified. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 14, 21, 23-25 and 42-49 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not provided a description of how the media that is *adhered* to the pad is removed. The media stripper shown in the drawings appears to simply be a roller.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 4, 6, 15-20, 22-24, 26-27, 29, 30, 31, 35, 38, 39, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Oikawa et al. (JP 2002-52760).

With respect to claim 16, Oikawa et al. discloses the transferring method including the steps of positioning a pad 2 at a transfer position of a transfer engine 92 using a pad storing cartridge 3 as shown in Figures 12 of Oikawa et al. The pad 2 is comprised of a plurality of transfer media sheets that are releasably secured to one another (see paragraph [0022] of the machine translation of Oikawa et al.). Paragraphs [0063]-[0064] describe how the sheets of pad paper 2 are printed.

With respect to claim 17, Figure 11 of Oikawa et al. shows the sheet being printed while it is releasably secured to the pad 2.

With respect to claim 18, Figure 12 of Oikawa et al. shows the sheet or transfer media being detached after it has been printed.

With respect to claim 19, Oikawa et al. discloses an image transfer apparatus including a means 3 for positioning a pad at a transfer position of a transfer engine 92 as shown in Figures 11-12 of Oikawa et al. the pad 2 is made of a plurality of sheets that are releasably secured to one another (see paragraph [0022] of the machine translation of Oikawa et al.). the positioning means

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includes a means 35a, 35b, 35c for adapting to varying peripheral pad dimensions as shown in Figure 4 of Oikawa et al.

With respect to claims 20, 26 and 38, Oikawa et al. discloses an image transfer apparatus including a housing 1, a transfer engine 92 and a transfer medium 2 at a transfer position as shown in Figure 12 of Oikawa et al. Further disclosed is a transfer medium registration system 35,a, 35b and 35c as shown in Figure 4 of Oikawa et al. for positioning the pad 2 so that the top sheet of the pad is located at the transfer position. Also disclosed by Oikawa et al. is a cartridge 3 for storing the pad.

With respect to claim 15, the image transfer apparatus disclosed by Oikawa et al. is a printer.

With respect to claim 22, Oikawa et al. discloses the transferring method including the steps of positioning a pad 2 made up of a plurality of transfer media releasably 6 secured to one another (see paragraph [0022] of the machine translation of Oikawa et al.) at a transfer position of a transfer engine 92 as shown in Figure 11 and transferring an image to one of the transfer media. Further disclosed is the step of detaching the transfer media from the pad when the image has been transferred as shown in Figure 12.

With respect to claim 23, Oikawa et al. discloses the claimed transferring method as mentioned with respect to claim 22 and further discloses a media stripper (the hand as shown in Figure 12) for removing the transfer medium.

With respect to claim 24, the removing step occurs after the transferring step.

With respect to claim 27, Oikawa et al. discloses an image transfer apparatus including a housing 1, a transfer engine 92 and a transfer medium 2 at a transfer position as shown in Figure

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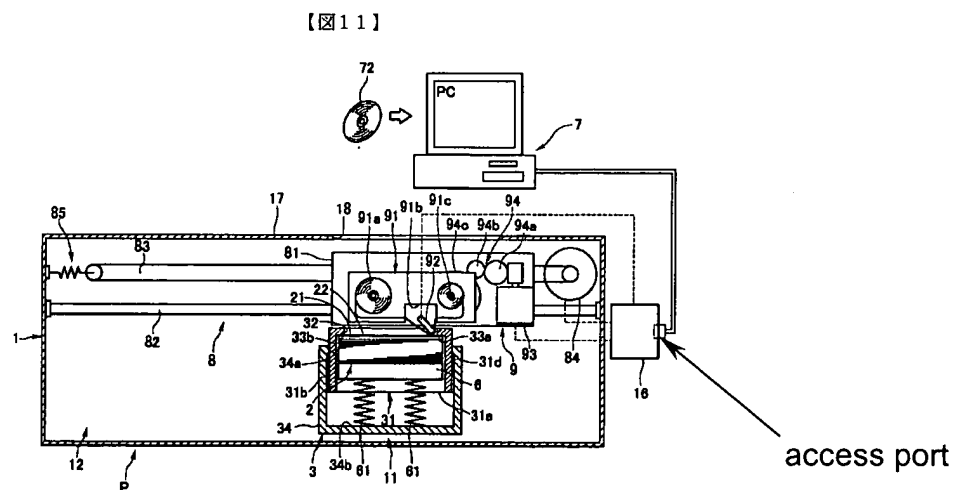
12 of Oikawa et al. Further disclosed is a transfer medium registration system 35a, 35b and 35c as shown in Figure 4 of Oikawa et al. for positioning the pad 2 so that the top sheet of the pad is located at the transfer position. The apparatus disclosed by Oikawa et al. is an imaging system with which the transfer engine 92 and registration system 35a, 35b and 35c are integrated.

With respect to claim 29, the system disclosed by Oikawa et al. further includes a ROM of a control section 71 for storing the image (see paragraph [0039]).

With respect to claim 30, the imaging system includes an image transmission system that transmits an image along a line from computer 7 to a control section 16 as shown in Figure 1 of Oikawa et al.

With respect to claim 31, Figures 11 and 4 show that the system is logically integrated with the transfer medium registration system 35a, 35b and 35c through sensors 36 and the transfer engine 92 which is connected directly to controller 16.

With respect to claim 35, Oikawa et al. discloses the claimed apparatus as mentioned in the above rejection of claim 20 and further discloses an access port in communication with transfer engine 92 as shown in below in the Figure 11 taken from Oikawa et al.:



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With respect to claims 6 and 39, Figure 4 of Oikawa et al. shows that the cartridge 3 is adaptable to differing dimensioned pads.

With respect to claim 40, Figure 11 of Oikawa et al. shows the top-most transfer medium of said pad having an image transferred to it.

With respect to claim 41, when the last page of the pad receives an image transferred from the transfer engine, it is a bottom-most transfer medium.

With respect to claim 4, Oikawa et al. discloses that the transfer engine 92 is a thermal transfer engine.

7. Claims 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato (US 5,638,750).

With respect to claim 32, Sato discloses an image transfer apparatus including a housing (outer surfaces of pressing plate 1 and platform 2), a stenciling system transfer engine 1, 3 and 4 a transfer medium registration system 5. While Sato does not disclose if the apparatus is used for positioning a pad including a plurality of transfer media releasably secured to one another, the apparatus is capable of performing such a positioning method.

With respect to claim 33, Sato discloses the claimed apparatus as mentioned above in the above rejection of 32, and it is further noted that the stenciling system disclosed by Sato can also be considered a stamping system since it applies the image by pressing a plate against a print medium.



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8. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Ozawa et al. (JP 8-133488).

Ozawa et al. discloses an image transfer apparatus including a housing 3, a transfer engine 5a within the housing 3 which transfers an image to the medium S at a transfer position as shown in Figure 3 of Ozawa et al. Further disclosed is a transfer medium registration system 3,11,14,15 which is coupled to the transfer engine 5a and positions a stack of medium S in the transfer position. Ozawa et al. also discloses a media stripper 11 for removing a sheet S. It is noted that applicant only recites the pad in functional language in the claim. The structure recited by Ozawa et al. would be capable of use with a pad to the extent that applicant has claimed.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oikawa et al. (JP 2002-52760), as applied to claims 4, 6, 15-20, 22-24, 26-27, 29, 30, 31, 35, 38, 39, 40 and 41 above, and further in view of Tomiki (US 5,926,682).

With respect to claim 2, Oikawa et al. discloses the claimed image transfer apparatus except for the electrostatic transfer system. However, Tomiki shows an example of a well-known electrostatic transfer system. It would have been obvious to replace the thermal transfer

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system disclosed by Oikawa et al. with the electrostatic transfer system of Tomiki for the high quality and resolution of printing that is afforded by an electrostatic transfer system.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oikawa et al. (JP 2002-52760), as applied to claims 4, 6, 16-20, 22-24, 26-27, 29, 30, 31, 35, 38, 39, 40 and 41 above, and further in view of Saka (JP 9-58073).

With respect to claim 2, Oikawa et al. discloses the claimed image transfer apparatus except for the electrostatic transfer system. However, Saka teaches an printing on a pad with an ink ejection system as shown in Figure 4 and mentioned in paragraph [0017] of the machine translation of Saka. It would have been obvious to replace the thermal transfer system disclosed by Oikawa et al. with the ink ejection system of Saka for the high quality, high resolution and high speed of printing that is afforded by an ink ejection system.

12. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oikawa et al. (JP 2002-52760), as applied to claims 4, 6, 15-20, 22-24, 26-27, 29, 30, 31, 35, 38, 39, 40 and 41 above, and further in view of Abe et al. (US 5,072,304).

Oikawa et al. discloses the claimed image transfer apparatus except for the image capture system. However, Abe et al. teaches an image transfer apparatus shown in Figures 9 and 10 which includes an image capture reading head 506. It would have been obvious to combine the teaching of Abe et al. with the image transfer apparatus disclosed by Oikawa et al. for the advantage of easily and readily obtaining images in digital form so that they may be reproduced in the image transfer apparatus.

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13. Claims 11-12 and 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oikawa et al. (JP 2002-52760) as applied to claims 4, 6, 15-20, 22-24, 26-27, 29, 30, 31, 35, 38, 39, 40 and 41 above, and further in view of Su et al. (US 2004/0056917).

With respect to claims 11 and 34, Oikawa et al. discloses the claimed image transfer apparatus except for the replaceable transfer engine. However Su et al., discloses an ink jet printer with a replaceable ink jet head 40 that can be replaced when the consumable (ink) used during image transfer is exhausted (Su et al., paragraph [0019]). It would have been obvious to combine the teaching of Su et al. with the apparatus disclosed by Oikawa et al. for the advantage of high quality and high speed printing afforded by ink jet print heads.

With respect to claim 12, in paragraph [0020] Su et al. discloses nozzles in an orifice plate for controllably ejecting ink. As mentioned above the cartridge contains ink.

14. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oikawa et al. (JP 2002-52760) as applied to claims 4, 6, 15-20, 22-24, 26-27, 29, 30, 31, 35, 38, 39, 40 and 41 above, and further in view of Kurashina (US 6,707,571).

With respect to claims 36-37, Oikawa et al. discloses the claimed image transfer apparatus except for the display. However, Kurashina discloses an image transfer apparatus with a display 4 that can display a transfer-ongoing mode (Kurashima, col. 64, lines 20-22). It would have been obvious to combine the teaching of Kurashima with the image transfer apparatus disclosed by Oikawa et al. for the advantage of allowing the user to know the status of the apparatus while looking at the apparatus.

*Allowable Subject Matter*

15. Claims 14, 21 and 42-49 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action, to the satisfaction of the examiner.

16. Claim 25 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action, to the satisfaction of the examiner, and to include all of the limitations of the base claim and any intervening claims.

17. The following is a statement of reasons for the indication of allowable subject matter:

Claim 25 has been indicated as containing allowable subject matter primarily for the step of removing the one transfer medium from the pad being performed prior to the transferring step.

Claims 14, 21 and 42-48 have been allowed primarily for the transfer medium registration system that locates the one transfer medium element at said transfer position and the media stripper for removing the transfer medium element from the pad. Note that Oikawa et al. (JP 2002-52760) does not teach a media stripper and Sakano et al. JP (2003-81457) does not teach a transfer medium registration system hat locates a transfer medium at a transfer position. The transfer position is located is located above the medium registration system as shown in Figure 9 of Sakano.

Claim 49 has been allowed primarily for the means for positioning a pad at a transfer position and the means for removing the transfer medium from the pad.

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***Response to Arguments***


18. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571)272-2157. The examiner can normally be reached Mon.-Thur. between 7:30 am and 6:00 pm. Faxes regarding this application can be sent to (703)872 - 9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571)272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 5, 2005

  
Daniel J. Colilla  
Primary Examiner  
Art Unit 2854